

REMARKS

Upon entry of the present amendment claims 1-24 are pending in the application. Claims 6, 7, and 11 have been amended to correct typographical errors. Claims 25-27 were previously canceled. No new claims have been added.

Amendments to, cancellation of, and additions to, the claims, as set forth above, are made in order to streamline prosecution in this case by limiting examination and argument to certain claimed embodiments that presently are considered to be of immediate commercial significance. Amendment or cancellation of the claims is not in any manner intended to, and should not be construed to, waive Applicants' right in the future to seek such unamended or cancelled subject matter, or similar matter (whether in equivalent, broader, or narrower form) in the present application, and any continuation, divisional, continuation-in-part, RCE, or any other application claiming priority to or through the present application, nor in any manner to indicate an intention, expressed or implied, to surrender any equivalent to the claims as pending after such amendments or cancellations.

1. Restriction Requirement Under 35 U.S.C. §121/372

It is the PTO's position that restriction is required between the inventions of Group I, claims 1-15, drawn to a pigment mixture, and Group II, claims 16-24, drawn to a method of making a pigment mixture. Restriction is said to be appropriate on the grounds that the claims lack unity of invention. In particular, the PTO states

...under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons: WO 01/59014 (hereinafter Li et al.) discloses a pigment mixture comprising platy effect pigment and spherical glass particles meeting the claimed requirements (see entire document).

Office Action of 17 November, 2008, page 2.

Applicants greatly appreciate the PTO's detailed comments but must respectfully disagree and traverse the restriction requirement.

First, the corresponding special technical feature common to claims 1 and 16 is not a pigment mixture comprising a platy effect pigment and spherical glass particles. Rather, the technical feature common to the composition of Applicants' claim 1 and Applicants' process of claim 16 for producing the composition of claim 2 is a pulverulent coating composition comprising a leaflet-shaped particle comprising a leaflet-shaped effect pigment in complete or near-complete parallel orientation to the surface of the leaflet-shaped particles (A), and transparent, dimensionally stable, non-leaflet-shaped particles (B). As disclosed in Applicants' claim 6, the leaflet-shaped particles (A) comprise an oligomeric and/or polymeric binder. The binder is described on p. 8, l. 19 to p. 11, l. 21 of the application. The (B) particles are not spherical glass particles, but are binder particles (p. 10, ll. 5-11), which can be curable physically, thermally, with actinic radiation, or both thermally and with actinic radiation (p. 13, ll. 4-6). As stated in the application (p. 13, ll. 8-10), the compositions of (B) are described in German Patent Application DE 10027270A1, p. 5 ¶ [0064] to p. 12, ¶ [0107]. In example 2, B is "a commercially customary powder clearcoat material based on methacrylate polymers" (p. 19 of the application). It is clear from this disclosure that (B) is not spherical glass particles.

Second, Applicants' pulverulent coating composition is not anticipated by the disclosures of et al.

Li et al. generally discloses a surface-modified pearl pigment, wherein a hydrated metal oxide is covered on the surface of a pearl pigment, and fine polymer particles, chemically bonded to a hydrated metal oxide-coated pearl pigment without being mutually aggregated, are adhered to the surface of the outmost layer of said hydrated metal oxide-coated pearl pigment. The leaflet-shaped effect pigment of the application does not require the metal oxide coating of Li et al.

Applicants' claims 1 and 16 recite a pulverulent coating composition, while Li et al. discloses a surface-modified pearl pigment, which is not itself a coating composition. Li et al. states that "the surface-modified pearl pigment according to the present invention can be used in printing inks for gravure printing, pad printing, offset printing, screen printing, etc., paints for automobiles, building walls etc., light-reflective paints for liquid crystal displays, paints for light semipermeable membranes . . ." (p. 16, ll. 11-16).

Moreover, Li et al. teaches the use of the surface-modified pearl pigment in solvent-borne systems, not in pulverulent coatings: “If the surface-modified pearl pigment according to the present invention is used in inks, paints, plastics or cosmetics, the surface-modified pearl occurs while floating preferentially in the surface of the media thereof (organic solvents for usual inks, paints, plastics and cosmetics, specifically e.g. various kinds of polyester acrylate resins, various kinds of polyurethane acrylates, various kinds of polyether acrylates, acrylic melamine resins, various kinds of aromatic solvents, natural fats and oils)” (p. 16, ll. 1-9).

In one embodiment, Li et al. generally discloses mixtures of surface-modified pearl pigments with spherical particles for use in printing inks (p. 16, ll. 18-19). They “have the function to break up existing pigment agglomerates, by action of the spherical particles being pressed into the accumulations of pigment in the course of the printing operation and causing these composite agglomerate structures to disintegrate (p. 16, ll. 19-23).

In contrast to the teachings of Li et al., Applicants’ transparent, dimensionally stable, non-leaflet-shaped particles (B) assist in and facilitate film formation, as opposed to Li’s sole purpose of breaking up pigment agglomerates. Nothing in Li indicates that Li’s pigment particles enter into film formation.

In view of the arguments set forth in Section 2, it is respectfully submitted that unity of invention does exist. Accordingly, restriction is not permissible under 37 CFR 1.499. Reconsideration and removal of the restriction requirement is respectfully requested.

However, per the requirements of 37 CFR 1.499 and 37 CFR 1.43, Applicants hereby elect the invention of Group I, claims 1-15 with traverse. If the restriction requirement is maintained, Applicants hereby authorize the cancellation of claims 16-24 as being drawn to a nonelected invention. The Undersigned further notes that the Restriction Requirement further required an election of species. However, clarification is requested since no species were identified.

CONCLUSION

Applicant(s) respectfully submit that the Application and pending claims are patentable in view of the foregoing amendments and/or remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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